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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,530

Applicant(s)

SCHWARTZ ET AL.

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/4/05
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-49, 51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) 22-36, 38-39, 41--46, 49, 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20, 21, 37, 40, 47, 48 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/2/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/21/2004 pg1 only</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains an amendment filed 9/2/05 and made responsive 12/8/05. Claims 51 and 52 were added. There was no statement as to what embodiment/species the new claims read on. As a courtesy, examiner called for clarification and Mr. Preda called back to state they read on the elected embodiment. While examiner can see how claim 51 could read on Fig 2, ring insert with closed hollow cylinder casing and external groove, claim 52 specifically contradicts the closed hollow casing, in that claim 52 includes a slot allowing the cylinder to change diameter. Thus Newly submitted claim 52 is directed to an invention that is independent or distinct from the invention originally claimed per above.

Since applicant has received an action on the merits for the originally presented invention, and applicant has expressly elected the ring insert with closed hollow cylinder casing and external groove, this invention's embodiment "a" has been expressly elected for prosecution on the merits. Accordingly, claim 52 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. Applicant states that the missing documents have been resubmitted to the Patent Office, but examiner has reviewed the entire USPTO electronic file and there is no resubmission. Further, examiner requested that the paper file be pulled and reviewed, and it was determined that no documents were received with the IDS of 9/2/2005.

However, the abstract for DE 10048889 was found attached to another reference. No abstract for DE 20015848 was located.

3. In addition, examiner has noted a foreign document, a search report for EP 03026090, which is also completely in German. Applicant describes the correlation of this to a foreign counterpart application, EP 03026090. No copy of EP 03026090, in English or German, was submitted, nor does this application have any priority claim to EP 03026090; therefore, the statement of relevance cannot be considered.

4. Applicant listed a foreign patent (Germany) 69605212 as provided. Examiner considered the document so provided. Applicant is encouraged to view this document in PAIR as it does not seem likely that the entire document has been provided, (since it is in German, examiner cannot be sure). As previously noted, examiner has considered what was provided (3 drawings and a few sentences of German prior to the abstract).

Drawings

5. The drawings are objected to because of the informalities in the attached Draftsman's review, form PTO-948.. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as

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“amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Note that when the asterisks are removed from the figures, the specification will need to be amended accordingly.

Claim Objections

7. Claims 1-18, 20-21, 37, 40, and 47-48, and 51 are objected to because of the following informalities: applicant has recited the alternatives of the edge and edge segments in an unclear manner. Applicant has also recited alternative of the “one of an anti-slip material and a vibration-damping material” in claims 1-18, 20-21, 37, 40, and 47-48 in a similar unclear manner. Further, examiner, as noted in the earlier office action, had assumed, as a courtesy to allow examination, that applicant was claiming alternatives unclearly, but applicant’s arguments indicate that applicant was trying to claim: A alone, B alone, or A and B together. The claim wording does not support that interpretation, so again the examiner objects and assumes the alternative expression for examination purposes. In addition, note that other alternatives are unclearly worded

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in similar manner - including but not necessarily limited to the following representative examples: "one of a securing ring and a retaining ring", "one of a rubber layer and an elastomeric layer", etc. Applicant should review all claims and ensure that they clearly recite alternatives - examiner has not specifically pointed out all examples. Examiner has examined all claims as best understood.

8. A Markush Group and its application are discussed in the MPEP Paragraph 2173.05(h).

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925).

Ex parte Markush sanctions claiming a genus expressed as a group consisting of certain specified materials. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See Ex parte Head, 214 USPQ 551 (Bd. App. 1981); In re Gaubert, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975); and In re Harnisch, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). It is improper to use the term "comprising" instead of "consisting of." Ex parte Dotter, 12 USPQ 382 (Bd. App. 1931).

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.

Similarly, the double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear. For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro."

The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are

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disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (MPEP § 803) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper.

Appropriate correction is required.

Regarding "permanently joined" and "non-removably fixed" - how is this defined?

With enough force and tools, everything is removable or non-permanently joined.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

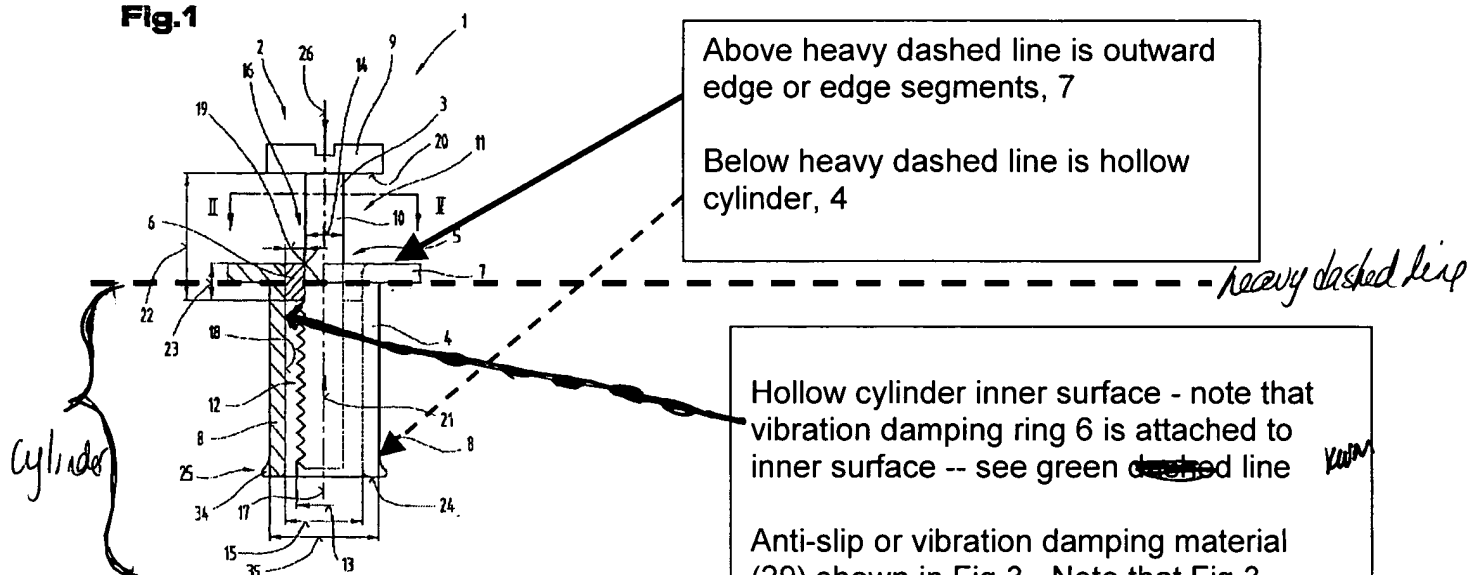
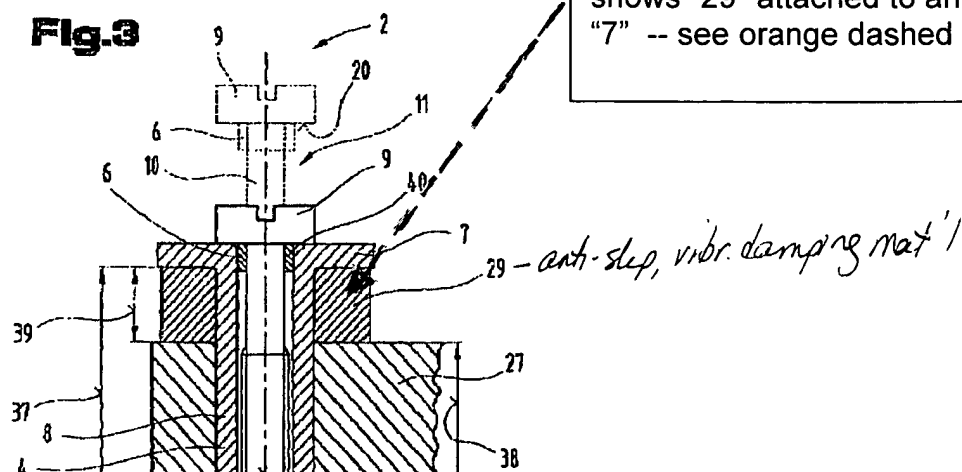
A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. As best understood, Claims 1 and 9 and 14 and 37 are rejected under 35 U.S.C. 102(a) as being anticipated by Radtke USPAP 2002/0009350.

Re claim 1: Radtke teaches a vibration damping ring inert arrangement comprising: A vibration damping ring(6). Note that while examiner refers to embodiment Fig 1-3, ring (6) is the same in both embodiments as described in para. [0029, 0040].

- A hollow cylinder (4) with 1st and 2nd ends and an inner surface connected to the outer surface of the ring
- An outwardly extending edge 7 arranged at the 2nd end (flange-like projection 7 in Fig 1 and 3.)
- Anti-slip or vibration damping material (29) attached to an annular surface of the edge or edge segments, either of which are outwardly extending.

Fig.1**Fig.3**

Re claim 9: The outwardly extending edge is substantially perpendicular to an axis (17) running through the cylinder.

Re claim 14: Para [0038] teaches the ring made of rubber.

Re claim 37: Part 27 and part 28 are coupled via the vibration damping insert arrangement per Fig 3 and paras [0031] and [0037]. Note that “through-opening” was not claimed.

11. As best understood, Claims 1, 9-15, 17, 20, 37, and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Roth USP 5397112.

Re claim 1: Roth teaches a vibration damping ring inert arrangement comprising:

- A vibration dampening ring (16, lower part at and below encircling ring 22 as oriented in Fig 2 below)), col 3 line 64-col 4 line 40.
- A hollow cylinder (12) with 1st and 2nd ends and an inner surface connected to the outer surface of the ring (16, lower part)
- An outwardly extending edge arranged at the 2nd end (14, Fig 2.)
- Anti-slip or vibration damping material (16, upper part above encircling ring 22 as oriented in Fig 2 below) attached to an annular surface of the edge or edge segments, either of which are outwardly extending. Also, note that “ring” and “material” are not equivalent terms, and thus the vibration damping ring can be considered to be the entire unit “16”, made in its entirety of the anti-vibration or anti-slip material – the “ring” element can also be the “material” composition.

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Interpretation 1:

anti-slip or vibration damping material
is above blue lens

— blue dashed line

vibration damping ring, below
blue dashed line.

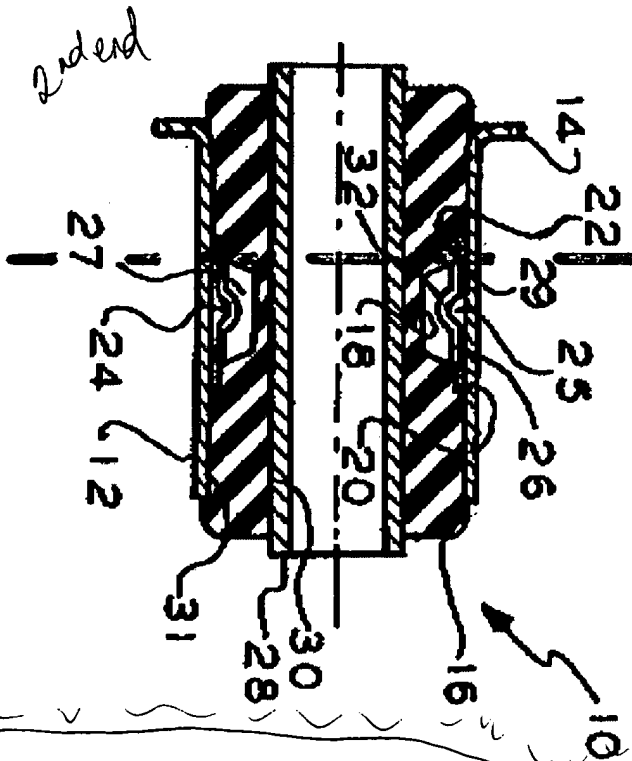


FIG. 2

Interpretation 2:

entire elastomeric cylinder 16 is
vibration damping ring, made of
anti-slip, vibration damping material

Red vertical line - represents
annular surface of extending
edge - anti-slip material attached to
annular surface
of edge.

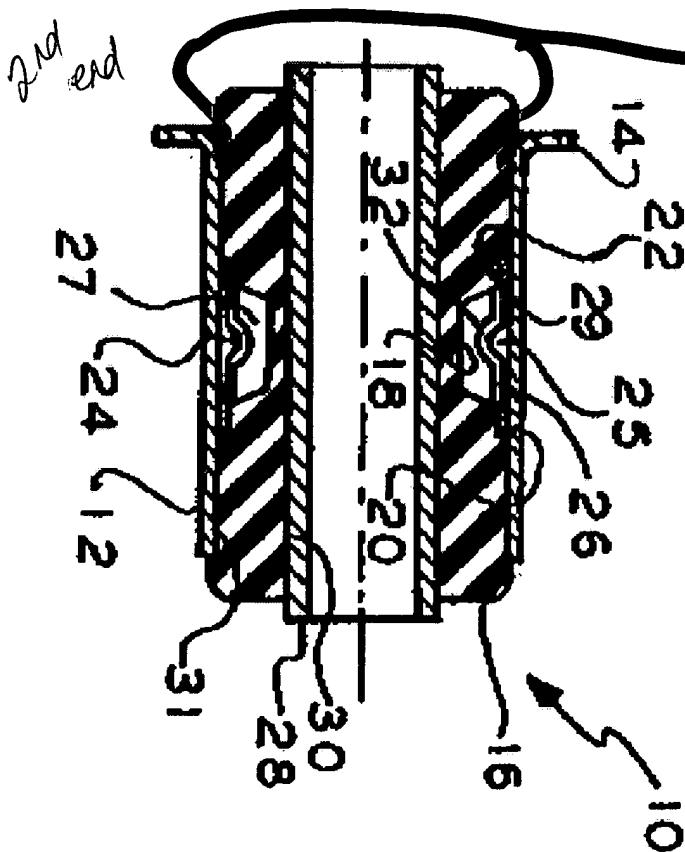
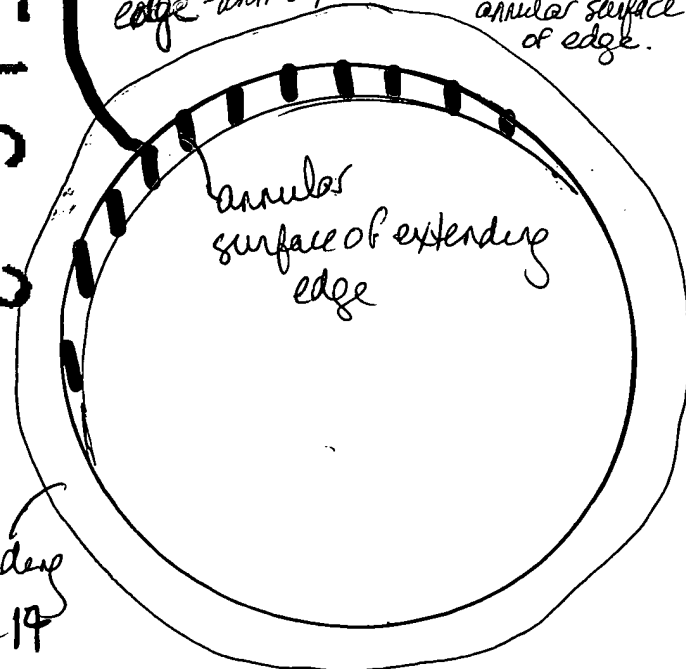


FIG. 2

extending
edge 14



Re claim 9: The outwardly extending edge is substantially perpendicular to an axis (Fig 2) running through the cylinder.

Re claims 10-12 and 47: Fig 2 shows the vibration-dampening ring having 1st and 2nd annular projection portions extending beyond the respective ends of the hollow member by an equal given amount. Note that in this situation, the vibration damping ring is considered the entire element "16", and the anti-slip and vibration-damping material is the material that the ring is made from.

Re claim 37, 48: Roth col 6 lines 47-64 discusses first and second component attachment via the inert.

Re claim 13: Fig 2 shows the 2nd end as an annular base surface.

Re claims 14 and 20: Col 3 line 67 – col 4 line 6 teaches the vibration dampening ring is rubber.

Re claim 15 : Col 2 lines 50-63 disclose that the ring 16 is locked to the inner and outer tubes by static friction. Absent any further limitation, it is considered permanently joined as examiner best understands applicant's claim (see claim objection above). **However**, if it is held that this teaching is not considered permanent, an alternate rejection is provided below under 103(a) rejections.

Re claim 17: Cylinder 12 is disclosed as metal (steel) in col 3 lines 66-67.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. As best understood, Claims 15 and 16 and 18 and 21 are rejected under 35 U.S.C. 103(a) as obvious over Roth USP 5397112.

Re claim 15: If it is held that Roth does not teach permanent attachment in his embodiment and the background of the invention, Roth does teach attachment by frictional locking. Col 2 lines 1-9 teach that prior art methods include bonding with a bond agent, but that this was considered by Roth as an expensive alternative. Thus Roth discloses that adhesives or vulcanization are known alternatives to the frictional locking used, which examiner assumes applicant considers permanently joining or non-removably fixing. The fact that Roth chose one alternative does not teach against the other disclosed alternatives. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have joined the vibration ring to the cylinder in a permanent manner, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Re claim 16 and 21: Col 2 lines 60-63 teach that the ring 16 is locked "without an adhesive and vulcanization". Col 2 lines 1-9 teach that prior art methods include bonding with a bond agent, but that this was considered by Roth as an expensive alternative. Thus Roth discloses that adhesives or vulcanization are known alternatives to the frictional locking used. The fact that Roth chose one alternative does not teach against the other disclosed alternatives. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth before him at the time the

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invention was made, to select another alternative known means of joining from well-known alternatives based on application needs.

Re claim 18: Roth discloses “steel” as discussed above, but is not specific that it is spring steel. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have selected spring steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, and a resilient mount or bushing with elastomeric core/ring would be expected to need a certain amount of flex as would be provided by spring steel. *In re Leshin*, 125 USPQ 416.

14. As best understood, Claim 20 is rejected under 35 U.S.C. 103(a) as obvious over Radtke. Radtke describes that anti-slip and vibration-damping material 29 as “damping element 29” and shows it with the drawing hatching as element “6”. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have made the damping element of rubber and elastomeric layers, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416, and rubber and elastomeric layers are well-known to provide damping properties.

15. As best understood, Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of Bondarowicz et al, USPAP 2002/0009351, hereafter called Bondarowicz.

Re claims 2 and 3: As discussed above, Roth teaches all the elements except

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a plurality of outwardly extending resilient retaining members. Bondarowicz teaches a cylindrical insert component comprising a plurality of outwardly extending resilient retaining members (30) which serve to secure the hollow cylinder element in a component opening. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth and Bondarowicz before him at the time the invention was made, to modify Roth as taught by Bondarowicz to include a plurality of outwardly extending resilient retaining members of Bondarowicz, in order to obtain an insert that could be self-retained and centered in a hole, as the outer sleeve 12 is designed to be secured to a second member in col 6 lines 47-53. One would have been motivated to make such a combination because it would require less time and cost to be inserted into a component, thus improving efficiency.

16. As best understood, Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radtke in view of Bondarowicz et al, USPAP 2002/0009351, hereafter called Bondarowicz.

Re claims 2 and 3: As discussed above, Radtke teaches all the elements except a plurality of outwardly extending resilient retaining members. Bondarowicz teaches a cylindrical insert component comprising a plurality of outwardly extending resilient retaining members (30) which serve to secure the hollow cylinder element in a component opening. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Radtke and Bondarowicz before him at the time the invention was made, to modify Radtke as taught by Bondarowicz to include a plurality of outwardly extending resilient retaining members of Bondarowicz, in order to obtain an

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insert that could be self-retained and centered in a hole. One would have been motivated to make such a combination because it would require less time and cost to be inserted into a component, thus improving efficiency.

17. As best understood, Claims 4-8 and 10-12 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radtke in view of Hein USP 5261650.

Re claims 4-8: As discussed above, Radtke teaches all the elements except the hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring. Hein teaches a snap-in mount that is frustoconical, not cylindrical, that includes an external circumferential retaining groove (u-shaped recess at 39) with a retaining ring (33) having inwardly extending spring tappets (37,38) on the retaining ring. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Radtke and Hein before him at the time the invention was made, to modify Radtke as taught by Hein to include a hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring of Hein, in order to obtain an insert that could be locked securely in place in a hole. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected.

Re claims 10-12: Hein shows the vibration-dampening ring having 1st and 2nd annular projection portions extending beyond the 1st and 2nd ends of the hollow frustoconical member by “substantially” equal given amounts. Therefore, it would have

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been obvious to one of ordinary skill in the art, having the teachings of Radtke and Hein before him at the time the invention was made, to modify Radtke as taught by Hein to include the vibration-dampening ring having 1st and 2nd annular projection portions extending beyond the 1st and 2nd ends of the hollow frustoconical member by “substantially” equal given amounts of Hein, in order to obtain an insert that could accept and absorb pressure at the ends without damage, noise, or vibration. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected. Note that “substantially” has been held to be a broad term:

“Substantially” is a broad term. --In re Nehrenberg (CCPA) 126 USPQ 383.

“Substantially the same as” and “substantially corresponding to” imply clearly that something less than exact correspondence is required. --Performed Line Products Co. v. Fanner Mfg. Co. (DC NOhio) 124 USPQ 288.

Re claim 51: As discussed above with respect to claim 1, Radtke teaches a vibration damping ring inert arrangement comprising:

- A vibration damping ring (6) with a through opening. Note that while examiner refers to embodiment of Fig 1-3, ring (6) is the same in both embodiments and is described in paragraphs [0029] and [0040].
- A hollow cylinder (4) with 1st and 2nd ends and an inner surface connected to the outer surface of the ring
- An outwardly extending edge 7 arranged at the 2nd end (flange-like projection 7 in Fig 1 and 3.)

- Anti-slip vibration damping material (29) attached to an annular surface of the edge or edge segments, either of which are outwardly extending. It is permanently attached as long as the insert arrangement is intact, and thus considered permanently attached.

However, Radtke fails to teach an arrangement for securing the hollow cylinder in an opening comprising a securing ring. Hein teaches a snap-in mount that is frustoconical, not cylindrical, that includes an external circumferential retaining groove (u-shaped recess at 39) with a retaining ring (33) having inwardly extending spring tappets (37,38) on the retaining ring. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Radtke and Hein before him at the time the invention was made, to modify Radtke as taught by Hein to include a hollow cylinder having an external circumferential retaining groove with a retaining ring of Hein, in order to obtain an insert that could be locked securely in place in a hole. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected.

18. As best understood, Claims 4-8 and 40 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of Hein USP 5261650.

Re claims 4-8 and 40: As discussed above, Roth teaches all the elements except the hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring. Hein teaches a snap-in mount that is frustoconical, not cylindrical, that includes an external

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circumferential retaining groove (u-shaped recess at 39) with a retaining ring (33) having inwardly extending spring tappets (37,38) on the retaining ring. This ring would obviously elastically compress the hollow cylinder to some degree. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth and Hein before him at the time the invention was made, to modify Roth as taught by Hein to include a hollow cylinder having an external circumferential retaining groove with a retaining ring having inwardly extending spring tappets on the retaining ring of Hein, in order to obtain an insert that could be locked securely in place in a hole. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected, including the automotive applications discussed in Roth col 6 lines 47-64.

Re claim 51; Roth teaches a vibration damping ring inert arrangement comprising:

- A vibration dampening ring comprising a through opening (16, lower part at and below ring 12 as oriented in Fig 2 below)), col 3 line 64-col 4 line 40.
- A hollow cylinder (12) with 1st and 2nd ends and an inner surface connected to the outer surface of the ring (16, lower part)
- An outwardly extending edge arranged at the 2nd end (14, Fig 2.)
- Anti-slip vibration damping material (16, upper part above ring 12 as oriented in Fig 2 below) attached to an annular surface of the edge or edge segments, either of which are outwardly extending. Also, note that

“ring” and “material” are not equivalent terms, and thus the vibration damping ring can be considered to be the entire unit “16”, made in its entirety of the anti-vibration or anti-slip material -- the “ring” element can also be the “material” composition.

However, Roth fails to teach an arrangement for securing the hollow cylinder in an opening comprising a securing ring. Hein teaches a snap-in mount that is frustoconical, not cylindrical, that includes an external circumferential retaining groove (u-shaped recess at 39) with a retaining ring (33) having inwardly extending spring tappets (37,38) on the retaining ring. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Roth and Hein before him at the time the invention was made, to modify Roth as taught by Hein to include a hollow cylinder having an external circumferential retaining groove with a retaining ring of Hein, in order to obtain an insert that could be locked securely in place in a hole. One would have been motivated to make such a combination because it would resist movement due to vibrations, and provide more secure attachment in applications where vibrations are expected.

Response to Arguments

19. Examiner apologizes for failing to type “claim 37” in the rejection, although the limitations were clearly pointed out with respect to claims 1, 47, and 48, which contained all the limitations of claim 37, and claim 37 was noted as rejected on the PTO-326. However, since applicant has amended claim 37, the issue is moot.

As discussed above under “Claim Objections”, applicant has not corrected the problem with the alternative claim language. Examiner notes that a Markush claim language was not required, only suggested. However, “one of {A} and {B}” is not clear alternative language, nor clear conjunctive language. While claims are read in light of the specification, it must be clear what is being claimed.

As to examiner not showing how the claims are unclear, it has been spelled out, but examiner also notes:

and (ænd, ən; ănd *when stressed*) *conj.*

1. Together with or along with; in addition to; as well as. Used to connect words, phrases, or clauses that have the same grammatical function in a construction.
2. Added to; plus: *Two and two makes four.*¹

or (ôr; ər *when unstressed*) *conj.*

1. a. Used to indicate an alternative, usually only before the last term of a series: *hot or cold; this, that, or the other.* b. Used to indicate the second of two alternatives, the first being preceded by *either* or *whether*: *Your answer is either ingenious or wrong. She didn't know whether to laugh or cry.* c. *Archaic.* Used to indicate the first of two alternatives, with the force of *either* or *whether*.²

Markush group wording allows “and” as part of the alternative because something is selected from the group consisting of A, B, and C... However, without the “--selected from the group consisting of” wording, “and” is conjunctive and “one of {A} and {B}” is unclear.

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Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection, since the new grounds of rejection include the new limitation. Although applicant has amended the independent claims, some arguments remain pertinent, since examiner is citing the same references. "Attached to an annular surface" does not require being attached to the outwardly extending edge. As noted in the drawings in the office action, the cylinder stops such that its second end is connected to the bottom (as oriented in the drawings) planar surface of the outwardly extending edge. However, that edge is a 3-dimensional structure, which in its entirety forms an annulus. Thus the inner surface of the outwardly extending edge, which is parallel and directly connected to the inner surface of the cylinder, is also an annular surface, since it is a surface of an annular object (i.e., the extending edge). (See marked up drawings)

Applicant state that RADTKE fails to disclose that the outwardly extending edge and edge segments are not substantially perpendicular to the hollow cylinder -- Figs 1,3, and 4 clearly show the outward edge 7 substantially perpendicular to axis 17, 31.

Note that now Radtke's vibration damping ring is 6 and material is 29.

Regarding Roth claim 1, applicant has amended the claim, so certain features were not previously noted by examiner. See the marked-up Figure for both ways to interpret Roth teaching a cylinder with anti-slip and vibration damping material attached to annular surface of outwardly extending edge. Applicant is now arguing "attached to the flange" (page 19), but the claim does not require attachment to the flange.

Regarding the argument regarding dependent claims, 9-15,17, and 48, under ROTH, applicant has not set forth specific arguments, but has only re-recited the claims and said the art does not teach them. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Per the rejection above, the examiner has shown that it is taught in the art.

Regarding the 103 rejections over ROTH alone, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner noted that selecting from well-known alternatives or well-known materials has been considered to be within the general skill of a worker in the art. ROTH is clearly interested in vibration damping, and examiner notes that one would have been motivated to make such a combination of

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using vibration damping material because it would resist movement due to vibrations, one would use a retaining ring to provide more secure attachment in applications where vibrations are expected, and that spring steel would be used to provide the metal with the give required to allow the vibration damping material and ring to work. ROTH was clear that the ring needed to be attached, and that adhesives and vulcanization had been used before.

Applicant's specific argument of ROTH and BONDAROWICZ is that the newly-added limitation was not taught. Examiner has addressed that in the new rejection above. Regarding the argument regarding dependent claims 2 and 3, applicant has not set forth specific arguments, but has only re-recited the claims and said the art does not teach them. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Per the rejection above, the examiner has shown that it is taught in the art.

Applicant's specific argument of RADTKE and BONDAROWICZ is that the newly-added limitation was not taught. Examiner has addressed that in the new rejection above. Regarding the argument regarding dependent claims 2 and 3,

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applicant has not set forth specific arguments, but has only re-recited the claims and said the art does not teach them. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Per the rejection above, the examiner has shown that it is taught in the art.

Applicant's specific argument of RADTKE and HEIN is that the newly-added limitation was not taught. Examiner has addressed that in the new rejection above. Regarding the argument regarding dependent claims 4-8 and 10-12, applicant has not set forth specific arguments, but has only re-recited the claims and said the art does not teach them. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such

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references or objections. Per the rejection above, the examiner has shown that it is taught in the art.

Applicant's specific argument of ROTH and HEIN is that the newly-added limitation was not taught. Examiner has addressed that in the new rejection above. Regarding the argument regarding dependent claims 4-8 and 20,21, and 40, applicant has not set forth specific arguments, but has only re-recited the claims and said the art does not teach them. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Per the rejection above, the examiner has shown that it is taught in the art.

Regarding new claim 51, applicant argues that RADTKE does not teach that element 29 is permanently attached or fixed to an annular surface of the edge 7. Examiner notes that para [0032] discloses the mounting of components 27 and 28 is simplified by providing a ready-fitted assembly. Further, [0037] teaches that 29 can have a "pre-tensioned thickness". Thus clearly it is at least "fixed" to the annular surface by being ready-fitted and pre-tensioned. Bondarowicz is not used. As noted above, it is not clear whether applicant requires the alternative. Since examiner does

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not see both the arms and ring in the elected embodiment, she is assuming the alternative.

Regarding new claim 51, applicant argues that ROTH does not teach that element is permanently attached or fixed to an annular surface of the edge. Examiner notes that col 6 lines 23-46 discloses the mounting of material 16 is fixed by compressive forces and no additional bonding is necessary, but it is clearly fixed. Bondarowicz is not used. As noted above, it is not clear whether applicant requires the alternative. Since examiner does not see both the arms and ring in the elected embodiment, she is assuming the alternative.

The rejection of claim 19 was stated as moot as the claim was canceled and examiner agrees,

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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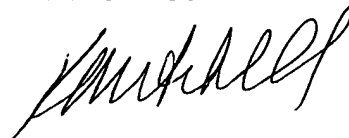
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Primary Examiner
Art Unit 3677



Kwm
2/18/2006